

Remarks/Arguments:

In response to the Final Office Action dated November 17, 2008, the Applicant's provide the following remarks in support of this preliminary amendment. Claims 1 through 12 and 14 through 16 are pending in this application.

Specification Informality

The Office Action objected to the specification use of reference numeral 18, indicating that the drawings that incorporate reference numeral 18 are objected to. Applicant notes that Fig. 2, including Replacement Sheet Fig. 2 provides notation to and identification of reference numeral 18. Applicant respectfully contends that Replacement Sheet Fig. 2 has never been at issue for any reason and properly shows the adhesive identified by numeral 18. Applicant respectfully suggests that this informality has been addressed and resolved. If Applicant is not correct with respect to a resolution of the informality through citation to Replacement Sheet Fig. 2, or any of the other Replacement Sheets identified along with this Preliminary Amendment, Applicant requests that the Examiner contact the undersigned counsel to have this minor issue resolved.

Drawing Objections and Single Set of Drawing Sheets

The Office Action objected to certain of the substitute drawings submitted on August 4, 2008. More specifically, the Office Action provided that the substitute drawings must be labeled as "Replacement Sheet" if the drawings are substitute drawings. More specifically, the Office Action required that "single drawing set" be supplied with any amendment. Accordingly, enclosed with this preliminary amendment is a single set of drawings including all of the figures with the proper notations as to "replacement sheets" and "new sheets" as required under 37 C.F.R. § 1.121(d). The enclosed drawing set includes six separate drawing sheets as follows:

- a. Replacement Sheet showing Figs. 1 and 2;
- b. Replacement Sheet showing Figs. 3 and 4;
- c. Replacement Sheet showing Figs. 5A and 5B;
- d. Replacement Sheet showing Fig. 6;
- e. New Sheet showing Figs. 5C and 5D; and
- f. New Sheet showing Figs. 7 and 8.

Applicant accordingly requests that the drawing rejections be withdrawn.

A. Rejections under 35 U.S.C. §§ 102 and 103

The Office Action rejected claim 1 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 4,538,827 (“Plifka”). The Office Action further rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,380,160 (“Hoffman”) in view of Plifka or U.S. Patent No. 4,290,281 (“Knaack et al.”). The Office Action further rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Garvey et al. and either Plifka or Knaack et al. The Office Action further rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner, Plifka and Garvey et al. The Office Action also rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Plifka in view of U.S. Patent No. 3,736,016 (“Garvey et al.”) and U.S. Patent No. 6,467,317 (“Hillabush et al.”). The Office Action further rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Plifka or Knaack et al. and in further view of U.S. Patent No. 3,736,016 (“Garvey et al.”) and Hillabush et al. The Office Action further rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner and Plifka and in further view of Garvey et al. and Hillabush. The Office Action further rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Garvey et al. and either Plifka or Knaack et al. and in further view of U.S. Patent No. 4,530,223 (“Oliver”). The Office Action further rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of White, Garner, Plifka and Garvey et al. and in further view of Oliver. The Office Action further rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Garvey et al. and either Plifka or Knaack et al. and in further view of Oliver and U.S. Patent No. 6,520,405 (“Braxter”). The Office Action further rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner, Plifka and Garvey et al. and in further view of Oliver and Braxter. The Office Action further rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Plifka in view of U.S. Patent No. 4,811,578 (“Masoncup et al.”). The Office Action further rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Plifka or Knaack et al. and in further view of Masoncup et al. The Office Action further rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner and Plifka and in further view of Masoncup et al. The

Office Action further rejected claims 1, 9, and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,473,001 (“White”) in view of U.S. Patent No. 6,463,769 (“Garner”) and Plifka. The Office Action further rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner and Plifka and in further view of Hillabush and Garvey et al. The Office Action further rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner and Plifka and in further view of Masoncup et al. The Office Action further rejected claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Garner, Plifka and Masoncup et al. and in further view of Hoffman.

Upon review, each of the noted 102 or 103 rejections is based upon either Plifka, Hoffman, or White, either alone or in combination with one or more other references as specifically identified in the preceding paragraph. Accordingly, if neither Plifka, Hoffman, nor White, alone or in combination with the other identified patents disclose all of the pending claim elements, then the reliance on Plifka, Hoffman and/or White, alone or in combination with the other patents does not provide a proper basis for an obviousness rejection. Moreover, unless Plifka discloses each of the claimed elements under claim 1 of the pending application, then Plifka is not a valid anticipatory reference.

More specifically, claims 1, 2, 9 and 16 include limitations that the protective cover must be used with a locking device, where the protective cover or shroud is attached to an access door. While claims 1 and 2 do not specifically claim an “access door” as an element of either claim, the claim language and claim elements are limited such that the protective cover is attached to an access door. In addition to the drawings and figures (including Figs. 3, 4, and 6) submitted with the application specification, the support for this limitation is clearly stated at page 7, lines 11 through 16 noting that the “apparatus has three primary components to allow use with a locking device and to secure unauthorized opening of an *access door*.”

By contrast, neither Plifka nor Hoffman disclose, show or reference in any fashion use of any covers with any access doors. Both Plifka and Hoffman solely describe use of a cover with tow bars, tow rings, and / or trailer hitches. The described and disclosed inventions and embodiments in Plifka and Hoffman do not show, suggest, or provide any reference to any type of

access door. Indeed, there is no suggestion or disclosure in either Plifka or Hoffman that a cover, such as the Hoffman cover 58, or the Plifka housing 28, is to be affixed to, attached to, or used with any access door. As previously noted, a review of the White patent shows that there is no suggestion or disclosure, or any motivation of any kind to include any type of cover or protection of the padlock 13 shown. White merely discloses a lock for a switch box where the switch box has a body portion 1 and a cover 2 that is hinged to the body portion.

Applicant has previously noted that Section 103 of the Patent Code precludes a patent “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art” (emphasis added). The “as a whole” instruction in Section 103 prevents evaluation of the invention part by part. “Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result--often the very definition of invention.” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004); *see also Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). As also recently explained by the U.S. Supreme Court and previously by the U.S. Court of Appeals for the Federal Circuit, the use of hindsight bias is not appropriate. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007); *In re Kamm*, 452 F.2d 1052, 1056-57 (CCPA 1972) (improper to pick and choose the claimed elements from among the various prior art references using the patent as a blueprint).

The mere fact that the White patent shows use of a padlock with a box cover provides no basis to suggest any combination, let alone an obvious combination with any other separate patent having a cover over the box or lock. The combination, through the use of hindsight, of White with Plifka or Hoffman has no suggestion or motivation when considered either independently or as a whole. The pending claims as amended, and narrowed specifically to application with access doors is a distinct invention that is not anticipated or rendered obvious in view of Plifka alone, or in combination with White or Hoffman. The Office Action concedes that the combination of at least

these three patents is “a reconstruction based upon hindsight reasoning.” Such an analysis surely can not be supported under the instruction of *KSR*.

Further, in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007), the U.S. Supreme Court relied upon “the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” Thus, as “a useful general rule,” a “reference that ‘teaches away’ can not create a prima facie case of obviousness.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994); *see also In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001) (reversing obviousness determination of the Board in a design patent case because the prior art teaches away from the claimed design) (“A prima facie case of obviousness can be rebutted if the applicant . . . can show ‘that the art in any material respect taught away’ from the claimed invention”). When a reference teaches away from the invention, an artisan could not be expected to combine it with another reference.

In that regard, as previously noted, the Hoffman cover 58 and tongue 30 do not provide a close fit for the padlock 50. The padlock 50 has substantial freedom to move even when in a locked configuration. The allowable movement and play of the Hoffman padlock appears to be the reason that Hoffman discloses holes 46 and 62 within tongue 30. Indeed, Hoffman would not be functional using a notch because the padlock 50 would simply fall away from the hasp even in a locked configuration. Applicant sees no suggestion or motivation in Hoffman to have the locking device tongue 30 with a notch as compared to the holes taught and disclosed. More accurately interpreted, the Hoffman design, with the allowable movement for the padlock specifically teaches away from the tongue 30 having a notch rather than holes 46 and 62.

Similarly, the Garner hasp 36, and the Garvey et al. hasp plate 30 both also only disclose use of holes within the hasp element, and do not show a notch element. Similar to Hoffman, both the Garner and Garvey et al. designs allow the lock (40 for both Garner and Garvey et al.) to have substantial movement and “play” even when the lock is in a locked or closed configuration. There does not appear to be any suggestion or motivation in Garner or Garvey et al. to use a notch in the hasp element instead of a hole. In all three of these references, Hoffman, Garner and Garvey et

al., the hasp element has a hole (or more than one hole) provided therein so that the padlock is held in place and can not be removed from the hasp.

The Supreme Court, in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007), rejected a rigid application of the requirement that some teaching, suggestion, or motivation (“TSM”) be proven before prior art references could be combined. At the same time, however, the Court acknowledged that the TSM test “captured a helpful insight[:] . . . a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” Thus, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741. Applicant contends that there is no “reason” identified, or even suggested “that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed” invention does. Merely identifying elements in prior patents does not provide any motivation, or suggestion, or reason that anyone would have combined such elements as the claimed invention has shown.

Accordingly, applicant respectfully contends that the advantages disclosed by independent claims 1, 2, 9 and 16 are not attained or suggested by the Plifka, Hoffman, Garvey et al., and/or Garner references. This is because claims 1, 2, 9 and 16 contain features as described above that are not taught or suggested by the applied references. As explained by Judge Rich in *In re Civitello*, 144 USPQ 10, 12 (CCPA 1964), when a claimed feature is not disclosed by the reference, the reference cannot render the claim obvious:

Since Haslachner fails to disclose the feature of the claim relied on, we do not agree with the patent office that it would suggest modifying the Craig bag to contain the feature. The Patent Office finds the suggestion, only after making a modification which is not suggested, as we see it, by anything other than appellant’s own disclosure. This is hindsight reconstruction. It does not establish obviousness. (Emphasis in original.)

Thus, Applicant respectfully does not agree with the Examiner that the Plifka, Hoffman, Garvey et al., and/or Garner references, alone or in combination with other references support a prima facie case of anticipation or obviousness over the claims as amended.

B. Dependent Claims

Because claims 3 through 8, and claims 10, 11, 12, 14, and 15 depend directly from a patentable claim, these dependent claims are also patentable. *See, e.g., In re McCarn*, 101 USPQ 411, 413 (CCPA 1954) (“sound law” requires allowance of dependent claims when their antecedent claims are allowed). Moreover, claims 3 through 8, and claims 10, 11, 12, 14, and 15 are each non-obvious in view of the applied references.

Conclusion:

By this Amendment, pending claims 1 through 8 have been amended directly (or indirectly through an amendment to an independent claim) to place the application in better condition for examination and allowance. Moreover, claims 9 through 12, and 14 through 16 have been further explained to be distinct from the several cited 103 patents. The rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) should be withdrawn. Favorable action is earnestly solicited.

Further, the Examiner is invited to call the applicant’s undersigned representative if any further action will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the application or the present Response. In fact, if the claims of the application are not believed to be in full condition for allowance, for any reason, the applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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☒ The Commissioner for Patents is hereby authorized to charge payment for any additional fee which may be required or to credit any overpayment to Deposit Account No. **502951**.

☒ Any response in this application requiring a petition for extension of time, but failing to include one, should be treated as though it does include the required petition for extension of time.